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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/986,499 | 11/09/2001 | Steven R. Meizlish | MAEI/06 | 5984 |
| 26875 | 7590 | 12/31/2003 | EXAMINER | |
| WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202 | | | SLACK, NAKO N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3635 | |

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,499

Applicant(s)

MEIZLISH, STEVEN R.

Examiner

Naoko Slack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-13 and 16-24 is/are rejected.
- 7) ☒ Claim(s) 3,4,14 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

In response to Applicant's Remarks received October 15, 2003, claims 1-24 have been reconsidered. As pointed out by applicant, the stipple pattern in Figure 2 of US Patent 5603546 to Desir Sr. denotes adhesive material. While the specification of Desir Sr. discloses that element 55 is "a double faced acrylic pressure sensitive adhesive tape" (column 3, lines 14-15), there is no mention of element 55 being a foam tape. While Desir Sr. is still applicable as a teaching for double-sided adhesive tape bonding a trim molding to a glass window panel, Desir Sr. is no longer used to teach that the tape comprises foam. A new rejection to claims 1, 2, 5-12, 16-24 is presented in this office action. Claims 3, 4, 14, and 15 contain allowable subject matter as indicated in the previous office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-13, 16-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,257,644 B1 to Young in view of US Patent 5,603,546 in view of Desir Sr. and US Patent 5419088 to Raymond et al.

Claims 1 and 12:

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Young discloses an extruded trim molding for a glass panel of an automobile, the trim (15, Figure 3) molding comprising a back wall (25, Figure 3), first and second opposing sidewalls (20 and 21, Figure 3) defining a channel with the back wall to receive the peripheral edge of a glass panel (12, Figure 3), adhesive (24, Figure 3) disposed on the back wall bonding the glass panel to the trim, and a third sidewall (drawn proximate to arrow 15, Figure 3) extending from a first end of the back wall in a direction substantially opposite the first and second side walls.

Young fails to show the use of a double-sided adhesive foam tape for attaching the glass panel to the trim molding. Desir Sr. discloses a glass panel attached to a molding using a double-sided adhesive tape (55, Figure 2 and column 3, lines 14-15) with a tape liner (69, Figure 3) for the benefits of reduced expansion differentials when the trim molding is exposed to high temperatures (column 4, lines 3-5).

In view of Desir Sr., it would have been obvious for one of ordinary skill in the art at the time the invention was made to use a double-sided adhesive tape on Young's trim molding to eliminate the inconsistencies upon application of liquid adhesive beads and to reduce expansion differentials in high temperatures (column 4, lines 2-5). Young is concerned with improving the adhesion between the molding and the window edge (column 1, lines 34-35).

While Desir Sr. fails to disclose that the double-sided adhesive tape is a foam tape, Raymond et al. discloses a double-sided adhesive foam tape (16, Figure 2 and column 3, lines 51-55) for attaching a window to a vehicle. Raymond et al. discloses that foam improves adherence of the window by absorbing energy from forces acting on the window (column 3, lines 56-60). In view of Raymond et al., it would have been obvious for one of ordinary skill in the art

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at the time the invention was made to use a double-sided adhesive foam tape on Young's trim molding to improve the adherence of the window to the automobile, as Young is concerned with improving adhesion between the window and the automobile molding (column 1, lines 34-35 and column 2, lines 8-10).

Claims 2 and 13:

Young teaches a trim molding where the third sidewall (18, Figure 2) extends from the first end of the back wall (25).

Claims 5 and 16:

Desir Sr. discloses adhesive (24, Figure 3) that bonds the molding to the peripheral edge of the glass panel (12, Figure 3).

Claims 6 and 17:

Young discloses that the molding is formed of extruded polymeric material such as PVC, having a shore hardness of around 80-90 (column 2, line 50).

Claims 7 and 18:

Young discloses that the molding is extruded as a continuous strip (column 2, lines 40-41).

Claims 8 and 19:

Young discloses that the molding is formed from PVC (column 2, line 49).

Claims 9 and 20:

Raymond et al. states that the foam tape comprises neoprene (column 7, line 13) , the trade name for chloroprene as per applicant's admission (page 8, line 2).

Claims 10 and 21:

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Raymond et al. states that the foam tape comprises butyl rubber based products and EPDM (column 7, lines 38-43). While SBR is not specified, SBR (styrene butadiene rubber) is a butyl rubber based product.

Claims 11 and 22:

Desir Sr. discloses a tape liner (69, Figure 3) to prevent premature adhesion of the tape.

Claims 23 and 24:

Young in view of Desir Sr. and Raymond et al. disclose the method of installing a glass panel into the opening of an automobile body comprising the steps of: providing and fitting a trim molding with a channel section around a glass panel (Young, Figure 3) such that an adhesive contacts the peripheral edge of the glass panel, removing a liner from the adhesive tape (Desir Sr., column 3, lines 51-53), using an adhesive foam tape (16, Raymond et al.), and installing the assembly into the opening of the automobile (Desir Sr., column 3, lines 59-61). While the step of preparing the automobile body to receive the glass panel is not specified, it is commonly known by one of ordinary skill in the art to prepare the surface prior to application of an adhesive.

Allowable Subject Matter

As stated in the previous office action, claims 3, 4, 14, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Relevant Prior Art

US Patent 5759679 discloses a double-sided foam tape used on automobiles comprising SBR, EPDM and chloroprene.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose telephone number is (703) 305-0315. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703) 308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



NS

December 11, 2003